

REMARKS/ARGUMENTS

This Response is being filed in response to the outstanding Non-final Rejection, dated March 21, 2007, to which Applicant was given a three-month period to reply. Accordingly, the present response is being timely filed.

Claims 1-23, and 25 are presently pending in the application. In the present Response, Applicants amend claims 1-3, and 12-14, cancel claim 24, without prejudice, and add new claim 25. Claims 1 and 25 are independent.

Basis of Rejection

In the Office Action, the Examiner rejected claims 1-24 under 35 U.S.C. §103 as being unpatentable over Reiley et al., USP 6,576,919, in view of Borzone, USP 5,122,134, in view of Gelpcke, USP 1,852,296. The Borzone reference is being cited for the first time.

Specifically, in rejecting claims 1-24, the Examiner asserted that all of the elements of independent claims 1 and 24 were disclosed by Reiley, except that Reiley failed to teach that the tip on the distal end of the probe has a first cross-section having a first area greater than a second cross-section having a second area situated between the first location and proximal end of the probe shaft. Nevertheless, the Examiner cites Borzone as teaching use of a tip that has such characteristics. Rejection p. 2-3. The Examiner also cited Gelpcke as disclosing a device having a plurality of surfaces aligned with the longitudinal axis and a polygonal cross-section. Id. at 3.

Response to Rejection

Applicants have amended independent claim 1 to claim that the shaft of the surgical instrument includes first and second bevels of varying degree. New independent claim 25 also includes this feature. Specifically, Applicants claim “a first bevel located at a first position

adjacent to the distal end of the tubular shaft of the probe sleeve and extending towards the proximal end at a first angle relative to the first longitudinal axis” and “a second bevel located at a second position adjacent to the first position and extending towards the proximal end of the probe sleeve at a second angle relative to the first longitudinal axis.” See claims 1 and 25.

The claimed elements of having first and second bevels formed in the shaft of the surgical instrument in addition to the facets of a tip formed on a distal end of the shaft is neither taught nor suggested by Reiley, Borzone, or Gelpke or any combination thereof. In particular, Reiley plainly depicts a shaft of a surgical instrument having a purely circular cross-section without any bevels formed in its surface. For example, Figure 1 of Reiley shows a cannula 50 with a tubular shaft having no bevels located adjacent to the distal end 54. Similarly, as shown in Figure 2, the trocar 30 of Reiley also has no bevels located adjacent the distal end 34.

Borzone also fails to teach or suggest first and second bevels formed in the shaft of the surgical instrument. The drive shaft 16 of the reaming device shown in Borzone has a circular cross-section adjacent the distal end where the reaming head 14 is located. Thus, Borzone makes no teaching or suggestion, and provides no motivation, to modify the tubular drive shaft to include first and second bevels formed in the shaft.

In addition, Borzone, in contrast to the surgical instrument of the present claims, describes a surgical reamer for reaming out holes already formed in bone. Thus, Borzone is non-analogous art to the claims of the present application. Specifically, as shown in Figure 3, the reaming head of Borzone has a plurality of flutes 20 separated by grooves 21. The shape of the reaming head of Borzone generally shows a head having a greater cross-sectional area at a point located between the proximal and distal ends. However, the reaming head of Borzone does not disclose a tip forming a point for penetrating tissue. Instead, the head of Borzone is

specifically designed to include a passageway coaxial with an axis 25 (see, e.g., Figure 5) and, therefore, the flutes 20 do not “intersect to form a point,” as claimed. Thus, contrary to the Examiner’s assertion, Borzone also fails to disclose the “tip” of the present claims.

Finally, the Examiner contends that Gelpcke teaches “a plurality of surfaces aligned with the longitudinal axis for preventing the shaft from turning inside a bore.” Rejection at p. 3. Applicants maintain their prior argument that the disclosure of Gelpcke is far afield and non-analogous to the field of the present application and thus is not properly combined with Reiley or Borzone as medical instruments. Nevertheless, Gelpcke fails to teach or suggest the first and second bevels formed in the shaft of the surgical instrument as set forth in independent claims 1 and 25. Specifically, the surfaces of Gelpcke are not bevels as they are parallel to the longitudinal axis of the tool of Gelpcke and do not extend at an angle relative to the longitudinal axis. As such, Gelpcke does not disclose the elements of independent claims 1 and 25.

Conclusion

In light of the above arguments, neither independent claims 1 and 25 nor any claim depending therefrom is rendered obvious by the Examiner's proposed combination of Reiley in view of Borzone in further view of Gelpcke. Thus, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney if a telephone call could help resolve and remaining issues.

The failure to discuss any prior argument in this Response should not be deemed a waiver of such arguments.

Date: June 21, 2007

Respectfully submitted,

/Richard Eskew/

Richard Eskew, Reg. No. 48,874

for:

Brian M. Rothery
Reg. No. 35,340
Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038
(212) 806-5400